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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,234	07/01/2005	Satoshi Kitazawa	Q85485	4040

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

CHEN, VIVIAN

ART UNIT PAPER NUMBER

1773

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/541,234	KITAZAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vivian Chen	1773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 6,7 and 14-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 12-13, 17-18, 20-22, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

JAPANESE PATENT APPLICATION 08-309940 (JP '940).

JP '940 discloses an antistatic film comprising a polyester base layer and an antistatic coating typically formed by inline coating, said coating comprising a resin containing polymerized units (1) and units derived from an acrylic monomer as recited in claim 4 in ratios as recited in claim 5. The coating further contains 20-80 wt% of an acrylic binder with the

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recited Tg or a polyester binder, and also less than 25 wt% of a surface active agent. The polyester base layer is typically polyethylene terephthalate, has a typical thickness of 1-300 microns, and can be either transparent or white. The antistatic film is optionally coated with UV curable ink and/or a magnetic layer. (entire document, see paragraphs 7, 9-21, 25-29, 43, 52-53, 55-57, 62, 67-74)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use effective amounts of conventional white pigments in the base layer of film of JP '940 in order to obtain a white laminate with desirable antistatic properties.

5. Claims 8-11, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAPANESE PATENT APPLICATION 08-309940 (JP '940) as applied to claim 1 above, and further in view of KOBAYASHI ET AL (US 6,221,461).

KOBAYASHI ET AL discloses that it is well known in the art to incorporate two types of particles of different sizes in polyester films in order to improve film handling properties, wherein the two kinds of particles can be individually selected from organic and inorganic particles, and wherein the film contains the two sizes of particles in amounts as recited in claim 8. The reference further discloses that it is desirable to utilize recycled polyester into the layers of the polyester film in order to reduce generation of waste materials. (line 10-20, col. 2; line 33, col. 5 to line 11, col. 6)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select the particle size and size distribution to minimize the presence of excessive surface irregularities (claim 8) to avoid undesirable visual and/or optical defects. One

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of ordinary skill in the would have applied an additional conventional functional layer to the multilayer film of KOBAYASHI ET AL in order to improve surface adhesion, film handling properties, etc.

6. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAPANESE PATENT APPLICATION 08-309940 (JP '940) as applied to claim 1 above, and further in view of SUMI (US 6,582,789).

SUMI discloses that it is well known in the art to apply an adhesive layer and a removable release layer on an antistatic polyester film in order to facilitate easy application to a variety of surfaces such as a liquid crystal polarizer plate. (line 62-68, col. 2)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply conventional functional layers such as adhesive and release layers in order to facilitate application of an antistatic film to conventional optical articles.

***Allowable Subject Matter***

7. Claims 6-7, 14-16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose or suggest a polyester film with an antistatic coating, wherein the antistatic coating contains polymerized unit (1), wherein the coating further

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comprises: (1) polymerized unit (2) (claim 6); (2) a polymer containing oxazoline groups (claim 14).

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 24, 2006



Vivian Chen  
Primary Examiner  
Art Unit 1773